

### **REMARKS**

Claims 31, 32, 35, and 36 are pending in this application. Claim 31 is amended, as explained below. These amendments are responsive to the Examiner's request for clarification in the claim language. Further, entry of these amendments would remove issues for appeal (i.e., the rejections under § 112). Therefore, Applicant respectfully submits that entry of these amendments is proper after final rejection.

### **REJECTIONS UNDER § 112**

Claims 31 and 32 are rejected as allegedly being non-compliant with the written description requirement of § 112, first paragraph. Without conceding to the propriety of this rejection, "attention deficit disorder" and "drive" are deleted from claim 31. Applicant respectfully submits that claims 31 and 32 are compliant with the written description requirement of § 112, first paragraph, and request withdrawal of the rejection. These amendments also overcome the New Matter objection under 35 U.S.C. § 132(a).

Claim 31 is rejected as allegedly being non-compliant with the definiteness requirement of § 112, second paragraph. For clarification, claim 31 is amended to recite both "psychiatric disorder" and "psychiatric function," as in the preamble. Applicant respectfully submits that claim 31 is compliant with the definiteness requirement of § 112, second paragraph, and request withdrawal of the rejection.

### **REJECTIONS UNDER § 102**

A. *Schiff* (U.S. Patent No. 5,938,688)

Claims 31 and 32 are rejected as allegedly being anticipated under § 102(b) by Schiff. Applicant respectfully requests reconsideration.

Independent claim 31 recites "delivering a second electrical stimulus to another area of the brain, wherein the another area of the brain is not the intralaminar nuclei."

*Schiff* does not disclose applying an electrical stimulus to another area of the brain that is

not the intralaminar nuclei. The passage referred to in the Office Action (*Schiff* at col. 13, Ins. 42-49) describes how to correlate areas of the brain having reduced baseline function to an intralaminar nuclei subdivision projecting thereto. *Schiff* then suggests that “[w]hen a subdivision is selected in this manner, electrical stimulation can be applied to the selected subdivision only, or, alternatively, it can be applied to the selected subdivision and, in addition, to other subdivisions of the patient’s intralaminar nuclei” (col. 14, Ins. 25-29). Thus, *Schiff* applies electrical stimulation only to the intralaminar nuclei.

For at least these reasons, Applicant respectfully submits that claims 31 and 32 are not anticipated by *Schiff*. Accordingly, withdrawal of the rejection is respectfully requested.

B. *Stypulkowski* (U.S. Patent No. 6,944,497)

Claims 31 and 32 are rejected as allegedly being anticipated under § 102(e) by *Stypulkowski*.<sup>1</sup> Applicant respectfully requests reconsideration.

The invention of claim 31 is a “method of treating a psychiatric disorder or a psychiatric function in a patient in need thereof.” The psychiatric disorder or function is selected from their respective Markush groups.

*Stypulkowski* describes a method of treating stuttering (see, e.g., col. 1, Ins. 6-9), and does not disclose any of the psychiatric disorders or functions recited in claim 31. Therefore, *Stypulkowski* fails to disclose a method of treating such psychiatric disorders or psychiatric functions in a patient in need thereof, as required by claim 31.

For at least these reasons, Applicant respectfully submits that claims 31 and 32 are not anticipated by *Stypulkowski*. Accordingly, withdrawal of the rejection is respectfully requested.

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<sup>1</sup> In consideration of this application’s priority claims to earlier filed applications, Applicant does not concede that *Stypulkowski* is prior art to claims 31 and 32. Applicant also reserves the right to antedate *Stypulkowski*

**CONCLUSION**

Applicant respectfully submits that the present application is in condition for allowance. The Examiner is invited to contact Applicant's representative to discuss any issue that would expedite allowance of this application.

The Commissioner is authorized to charge all required fees, fees under § 1.17, or all required extension of time fees, or to credit any overpayment to Deposit Account No. 11-0600 (Kenyon & Kenyon LLP).

Respectfully submitted,

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Date: 27 May 2008

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at a later time. However, because Applicant believes that the rejection can be overcome on its merits alone, the issue of whether *Stypulkowski* qualifies as prior art is not addressed in this response.